

REMARKS/ARGUMENTS

Claims 1-12 are pending in the instant application. Claims 1-12 stand rejected. Claim 1 has been amended. No claims have been cancelled or added. No new matter has been added. For the reasons set forth below, Applicant respectfully requests that the Examiner reconsider the rejections and allow all of the pending claims.

Obvious-type Double Patenting

Claims 1-2, 5-6 and 9-10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 23-24 of co-pending Application No. 10/645,550 to Jameson, U.S. Publication No. US2005/0044067 A1. A terminal disclaimer in compliance with 37 CFR 1.321(c) is filed herewith to overcome the provisional rejection as the conflicting application is shown to be commonly owned with this application.

Claim Rejections Under 35 U.S.C. 112

On page 4 of the Office Action, claim 1 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point and distinctly claim the subject matter which Applicant regards as the invention. With regard to claim 1, the Examiner stated that "the phrase 'on or with the aid of a computer' renders the claim indefinite. It is unclear which steps are performed on a computer and which are not." Applicant has amended claim 1 to particularly point and distinctly claim the invention. No new matter has been added.

Claim Rejections Under 35 U.S.C. 103(a)

On page 5 of the Office Action, claims 1-12 are rejected under 35 U.S.C. §103(a) as being unpatentable over Sundararajan, US 6,487,577 ("Sundaranrajan").

To establish a *prima facie* case of obviousness, the Examiner must make three basic showings. The basic criteria for establishing a *prima facie* case of obviousness are articulated in M.P.E.P. § 2142. *See also* M.P.E.P. §§ 706.02(j), 2143-2143.03; *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). First, there must be some suggestion or motivation, either in the reference(s) themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *Id.* Second, there must be a reasonable expectation of success. *Id.* Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *Id.*

The teaching or suggestion to modify the reference and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). *See* MPEP §2143 - §2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. MPEP §706.02(j). "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

It is further respectfully noted that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *Ex Parte Kume, et al*, 2006 WL 2558178 (Bd. Pat. App. & Interf. 2006) citing to *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990). The Supreme Court continues to caution that "A fact finder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning" *KSR*, 127 S.Ct. at 1742 (citations omitted).

Independent claims 1, 5 and 9

More specifically, the Office Action asserts that Sundararajan discloses a collection symbolic job request "where the 'collection symbolic job request' is read on 'job'". (Office Action at page 5, citing Sundararajan at column 7, lines 58-60, figure 6a) However, the cited passage does not disclose, teach or suggest this element, only that: "An illustration of the signal path is shown in FIG. 6a. In FIG. 6, the control signal travels from the client computer 604 through the NRS computer 608 to the SC computer 612. When the SC computer, completes the job, the SC computer transmits the results back to the client also via the NRS computer in step 524." From the specification in Sundararajan, a "job" is simply described as "typically binary data which describes a task to be performed. In the preferred embodiment, a job is a binary large object (BLOB) that is tagged with a job type identification so that the NRS computer knows the type of job being submitted." (*Sundararajan*, col. 3, lines 51-55.) On the other hand, Applicant claims a collection symbolic job request, which the present application defines as "A collection symbolic job request is comprised of two parts: (1) a symbolic task operation ("system, do this") and (2) an optional

symbolic collection reference expression (“to that”). (*Specification* of U.S. Patent Application Publication No. 2005/0044095 A1, Paragraph [0032].)

Therefore, at the very least, Sundararajan does not disclose, teach or suggest “collection symbolic job request” as disclosed and claimed by Applicant in independent claim 1. Independent claims 5 and 9 also include the element “collection symbolic job request.”

Moreover, acting as his own lexicographer, Applicant uses the word “collection,” in both the specification and the claims, to refer specifically to “the union of a collection specifier and a set of collection content.” *Specification* of U.S. Patent Application Publication No. 2005/0044095 A1, Paragraph [0011]. A “collection specifier” and “collection content” are further described in the application. *See Specification of Application*, Paragraphs [0012]-[0014]. Therefore, due to the inherent limitations to the claim terms, as defined by the details in the specification, Applicant submits that Sundararajan does not disclose at least a “collection” (including the inherent and special meanings as defined in the specification) referred to in “collection symbolic job request” as recited in the pending claims.

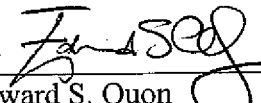
Therefore, based at least on the reasons above, Applicant respectfully submits that claims 2-4, which depend from claim 1, claims 6-8 which depend from claim 5, and claims 10-12, which depend from claim 9, are patentable over Sundararajan as applied to claims independent claims 1, 5 and 9.

CONCLUSION

On the basis of the above remarks, reconsideration and allowance of all the pending claims is believed to be warranted and such action is respectfully requested. If the Examiner has any questions or comments, the Examiner is respectfully requested to contact the undersigned at the number listed below. The Office is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1847.

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Respectfully submitted,

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